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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/663,387	09/16/2003	Daniel Easo	2003P11407 US	2914				
7590 12/12/2007								
Elsa Keller Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>PEACHES, RANDY</td></tr></table>			EXAMINER	PEACHES, RANDY		
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		<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2617</td><td></td></tr></table>			ART UNIT	PAPER NUMBER	2617	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,387

Applicant(s)

EASO ET AL.

Examiner

Randy Peaches

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to **claims 27-36** have been considered but are moot in view of the new ground(s) of rejection.

The Examiner has fully considered the applicant's argument regarding the method by which the previously cited prior art was used in rejecting the claim limitation.

Consequently, based on the newly cited prior art and the Examiner's broadest, most reasonable interpretation of the claimed language, the claims, per the below Office Action, stand fully rejected based on the newly cited prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 27-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy et al. (U.S. Patent Publication Number 2006/0111124 A1) in view of Vallstrom et al. (U.S. Patent Publication Number 20040192352 A1).

Regarding **claims 27, 30, 32 and 35**, Kennedy et al. discloses a method of enabling a mobile station in a wireless network to originate or receive a call during a mobile terminating location request (see first line of paragraph [0041]), comprising:

- initiating a mobile terminating location request, wherein the PDE determines the location of the call requesting mobile terminal. The PDE is considered as an external location determining entity; therefore, constitutes as a MT-LR. See paragraph [0041].

However, although Kennedy et al. discloses the method of setting up a call and determining the location of the caller simultaneously, Kennedy et al. fails to clearly disclose of sending a network command to the mobile station during processing of the mobile terminating location request.

Vallstrom et al. teaches in FIGURE 3A wherein during a said MT-LR, a DTAP, which reads on claimed "network command," is sent during the processing of the MT-LR.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Kennedy et al. in view of Vallstrom et al. in order to provide a system that is capable of processing a call request and a location determination process simultaneously by sending a DTAP to the said mobile station.

Regarding **claims 28 and 33**, as the combination of Kennedy et al. and Vallstrom et al. are made, the combination according to **claims 27 and 32**, the combination continues

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to disclose wherein sending a said DTAP to the mobile station (tracking device) immediately following the mobile terminating location request. See Vallstrom et al.

FIGURE 3A.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Kennedy et al. in view of Vallstrom et al. in order to provide a system that is capable of processing a call request and a location determination process simultaneously by sending a DTAP to the said mobile station.

Regarding **claims 29, 31, 34 and 36**, as the combination of Kennedy et al. and Vallstrom et al. are made, the combination according to **claims 27, 30, 32 and 35**, continue to disclose wherein sending a network command to the mobile comprises sending a direct transfer application part message. See Vallstrom et al. FIGURE 3A.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Kennedy et al. in view of Vallstrom et al. in order to provide a system that is capable of processing a call request and a location determination process simultaneously by sending a DTAP to the said mobile station.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
RP


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER